

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

*Ex parte* ROBERT J. YATKA,  
DONALD J. TOWNSEND, SONYA S. JOHNSON,  
MICHAEL J. GREENBERG, and DANIEL J. SITLER

---

Appeal 2006-3009  
Application 10/712,114  
Technology Center 1700

---

Decided: January 29, 2007

---

Before EDWARD C. KIMLIN, CHUNG K. PAK, and  
CHARLES F. WARREN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

ORDER VACATING ORAL HEARING

On January 10, 2007, Mr. Eric Hawthorne, a Lead Paralegal of the Board of Patent Appeals and Interferences, informed appellants' counsel, Mr. Steven P. Shurtz, that the Merits Panel assigned to this application had decided to remand the Application to the Examiner for further proceedings.

Mr. Hawthorne further informed Mr. Shurtz that therefore, the Oral Hearing scheduled for January 11, 2007, will be vacated.

Accordingly, as counsel was informed on January 10, 2007, it is ORDERED that the Oral Hearing scheduled for 1:00 PM on January 11, 2007, is *VACATED*.

#### ORDER REMANDING TO THE EXAMINER

We remand the application to the Examiner for consideration and explanation of the issues raised by the record. 37 C.F.R. § 41.50(a)(1) (2006); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 5, August 2006).

The record shows that Appellants cite three non-patent literature references in the Evidence Appendix and provide copies of these documents in the Brief filed March 20, 2006 (Br., 14, “Appendix A,” “Appendix B,” and “Appendix C”). Appellants do not state in the Evidence Appendix that these references were previously made of record by the Examiner.

Appellants rely on these references in arguments (Br., e.g., 7-8 and 10).

The record further shows that Appellants appended the same references and submitted arguments based thereon in the Amendment filed February 6, 2006, in response to the Final Action mailed November 3, 2005. The Examiner refused entry of this Amendment in the Advisory Action mailed February 14, 2006.

37 C.F.R. § 41.37(c)(1)(ix) (2006) states in pertinent part:

An appendix containing . . . evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered

evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal.

37 C.F.R. §41.33(d) (2006) states in pertinent part:

(d)(1) [E]vidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date of filing a brief pursuant to § 41.37 may be admitted if the examiner determines that the . . . evidence overcomes all rejections under appeal and that a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented has been made.

(2) All other . . . evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be permitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1).

It is apparent that Appellants' submission of and reliance on three references in the Brief not previously made of record by the Examiner violates the above rules. *See* MPEP § 1206 (8th ed., Rev. 5, August 2006).

Accordingly, the Examiner is required to take appropriate action consistent with current examining practice and procedure to notify Appellants of the above deficiency in the Brief filed March 20, 2006, and provide Appellants with the opportunity to cure the same as provided in 37 C.F.R. § 41.37(d) (2006); MPEP § 1205.03 (8th ed., Rev. 5, August 2006), with a view toward placing this application in condition for decision on appeal with respect to the issues presented.

This Remand is *not* made for the purpose of directing the Examiner to further consider the grounds of rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) (2006) does not apply.

Appeal No. 2006-3009  
Application 10/712,114

We hereby remand this application to the Examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

REMANDED

clj

Wrigley & Dreyfus 28445  
Brinks Hofer Gilson & Lione  
P.O. Box 10395  
Chicago, IL 60610